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IN THE

# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965.

## No. 612

M. B. SKINNER COMPANY,
*Petitioner,*

vs.

CONTINENTAL INDUSTRIES, INC.,
*Respondent.*

## BRIEF OF RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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Respondent opposes the prayer of the Petition that Writ of Certiorari issue to review the judgment to which it is addressed, and respectfully prays consideration of the following:

### OPINIONS BELOW

The findings and opinions of the lower courts are correctly reflected in the Appendix to the Petition.

### JURISDICTION

The Petition is timely, and sufficiently invokes jurisdiction of this Court under 28 U. S. C., Section 1254 (1).

## STATUTES INVOLVED

While the Petition refers only to that Section of the 1952 Patent Act which is coded at 35 U. S. C., Section 103, its proper disposition will require additional reference to 35 U. S. C., Section 102, to Senate Report No. 1979 reflecting legislative history, and to Article I, Section 8, cl. 8, of the Constitution of the United States.

## QUESTIONS PRESENTED

Respondent disagrees emphatically that the questions as proposed by the Petition arise upon the record and judgments below.

Neither the judgment of the trial court, nor the opinion of the Court of Appeals is rested upon the determinations postulated by Petitioner, and which are necessarily postulated to derive its "Questions Presented".

The questions proposed, if they arise at all upon this record, are wholly adjective to the judgments addressed. The judgments below would stand unaffected, even if Petitioner's thesis were sustained.

The two questions attempted to be presented are treated separately in the Argument.

## STATEMENT OF THE CASE

Petitioner's statement of the case below is inadequate in a multitude of particulars, all of which need not be developed for the purposes of the pending issue.

It is specifically deficient, however, in its failure to disclose that both courts below held that the patent claims

in issue were obvious to one ordinarily skilled in the art (as well as not inventive, if this be a different standard), and therefore invalid. The trial court held this as a determination of fact,[1] and the Court of Appeals affirmed under familiar rules of decision. The trial court also held Respondent's accused device not to infringe, but the Court of Appeals did not review this question in view of its conclusion of invalidity.

## ARGUMENT

### Reasons for Refusal of the Writ

We address ourselves separately to the two questions presented in the Petition.

### QUESTION 1.

Petitioner urges no conflict of decision and no issue of public importance to justify review by this Court of Question 1. The case for review rests solely on the contention that the court below:

> ". . . Applied a non-statutory and improper test of patentability." (Pet. 5)

The gist of petitioner's position is that Congress, by the enactment of 35 U. S. C. 103, abolished the constitutional requirement for invention and, for the first time, authorized the extension of patent monopolies to merely novel devices which do not exceed the skill of the art. Such a contention is at odds not only with the express intent of Congress as reflected by the legislative history of the 1952 Patent Act, but also with all of the apposite

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1. See Findings of Fact Nos. 11, 12, 13, 24, 25 and 31, found at pp. 47-54 of the Record below, and at pp. 31-40 of the Appendix to the Petition.

decisions of this Court, and with the practical application of the patent system since its inception.

Petitioner states:

> "The erroneous test of patentability applied by the court below was stated, in part, as follows:
>
> "'. . . since it is a combination of old elements appellant must show both that it accomplishes a new and useful result and is inventive.'" (Pet. 5)
>
> * * *
>
> ". . . Certainly, the statute (35 U. S. C. 103) does not require *both* a new result and inventiveness." (Pet. 5)[2] (Emphasis in original)
>
> * * *
>
> "The court of appeals and the district court further erred in holding that the combination must be *inventive* to be patentable. The statute merely states that the combination must be unobvious to one skilled in the art. It says nothing about the combination being *inventive.*" (Pet. 7) (Emphasis in original)

Thus, Petitioner urges that the "unobviousness" test of Section 103 is wholly satisfied by a "new . . . result" —*i.e., merely novelty.* The failure of the lower courts to find a new result, and their direct finding of obviousness is ignored.

At least since the 1850 decision in *Hotchkiss* v. *Greenwood*, 52 U. S. 248, 13 L. Ed. 683 (1850), this Court has enforced the constitutional "requirement for invention" as a *separate, non-statutory* (until the enactment of Sec-

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2. In point of fact neither court below found that the combination of old elements in issue accomplished either "a new result" or that such combination was "inventive". Petitioner is thus forced to the extreme "position that failure to find a new result from the combination of old elements has no bearing on whether the improvement was obvious to those skilled in the art." (Pet. 7)

tion 103) prerequisite to patentability in addition to the *statutory* requirements of *novelty* and utility.

The fundamental distinction between "novelty" and "invention" was expressly preserved by Congress in the 1952 Patent Act.

35 U. S. C. *102(a)* and (b) was a recodification. It "repeats the conditions in the existing law (R. S. 4886) relating to novelty." (Sen. Rep. No. 1979, p. 5)[3]

35 U. S. C. *103*, one of the "major changes or innovations" (Sen. Rep. 1979, p. 4) of the 1952 Act was a codification of the pre-existing *non-statutory*, judge-made "requirements for invention." (Sen. Rep. 1979, p. 4)[4] which had "existed in the law for more than a hundred years, but only by reason of the decisions of the Courts." (Sen. Rep. 1979, p. 6)[5]

The "decisions of the Courts" enunciating the constitutional "requirement for invention" codified in Section 103 uniformly hold that "promotion of science and the useful arts" (Const., Art. I, Sec. 8, cl. 8) requires as a minimum, not merely *novelty*, but a contribution exceeding "the skill of the art . . ." —in other words, "invention." *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248, 13 L. Ed. 683 (1850); *Atlantic Works* v. *Brady*, 107 U. S. 192, 27 L. Ed. 438, 2 S. Ct. 225 (1883); *Reckendorfer* v. *Faber*, 92 U. S. 347, 23 L. Ed. 719 (1876); *Cuno Engineer-*

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3. The Revisor's note states:
"Paragraphs (a), (b), . . . are based on . . . RS 4886. . . .
". . . no change is made in these paragraphs other than that due to division into lettered paragraphs. . . ."

4. Senate Report No. 1979 states:
". . . The major changes or innovations in the title consist of incorporating *a requirement* for invention in § 103 and the judicial doctrine of contributory infringement in § 271."

5. See the quotation from Senate Report 1979, Petition, pp. 8, 9.

*ing Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58, 62 S. Ct. 37 (1941); *Great A&P Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951); *Crest Specialty* v. *Trager*, 341 U. S. 912, 95 L. Ed. 1349, 71 S. Ct. 733 (1951).

Of perhaps even greater significance is the fact that the interpretation of 103 to eliminate the "requirement for invention" as urged by Petitioner would impede "the progress of science and the useful arts" by authorizing patents for trifles in derogation of the Constitution as consistently construed by this Court for over a century. *Atlantic Works* v. *Brady*, 107 U. S. 192, 27 L. Ed. 438, 2 S. Ct. 225 (1883); *Thompson* v. *Boisselier*, 114 U. S. 1, 29 L. Ed. 76, 5 S. Ct. 1042 (1885); *Hill* v. *Wooster*, 132 U. S. 693, 33 L. Ed. 502, 10 S. Ct. 206 (1890); *McClain* v. *Ortmayer*, 141 U. S. 419, 35 L. Ed. 800, 12 S. Ct. 76 (1891); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58, 62 S. Ct. 37 (1951); *Great A&P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951); *Crest Specialty* v. *Trager*, 341 U. S. 912, 95 L. Ed. 1349, 70 S. Ct. 733 (1951).

Cognizant of the constitutional limitation on the patent power, this Court emphasized for many years that the defense of "no invention" might be raised in the absence of a statute (*Reckendorfer* v. *Faber*, 92 U. S. 347, 23 L. Ed. 719 (1876); *Mahn* v. *Harwood*, 112 U. S. 354, 355, 28 L. Ed. 665, 667, 5 S. Ct. 174 (1884); *Great A&P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951)) and *sua sponte* by the Court even if not pleaded by the infringer (*Brown* v. *Piper*, 91 U. S. 44; *Slawson* v. *Grand Street R. R. Co.*, 107 U. S. 649, 652, 27 L. Ed. 576, 577, 2 S. Ct. 663 (1883)).

There would have been no reason for Section 103 if the "obviousness" test it defines were implicit in the re-

quirement for *novelty* now *recodified* in 35 U. S. C. 102. In such a case, Section 103, far from being a "new statute" constituting one of the two acknowledged "major changes or innovations" in the 1952 Patent Act would have been an exercise in congressional futility.

The decision below applied the proper "test of patentability." The petition should be denied as to Question 1.

## QUESTION 2.

Question 2 presents an artificial issue inconsistent with the opinions of both lower courts and with the fact findings of the trial court.

Question 2 is concerned solely with Petitioner's second patent 2,990,731 which substitutes in the device of the first patent 2,950,637 an improved punching element provided with a hollow tip. Contrary to Petitioner's argument, the court below properly recognized that the hollow tipped punch was:

> ". . . the dominant element of the invention as claimed." (Pet. 12)

The court below found the hollow tipped punch *element* to be old and invalidated the claim on expressly the basis of such finding. The court said:

> "Much of what has been said about patent 2,950,637 applies to the second patent, number 2,990,731. *The only question here concerns the different punching-tip configuration.* The idea of a perforating tool with a hollowed end was used, *inter alia,* by Metz, patent number 1,020,302, in 1912, and by Alsaker, *supra.* The key to the punching tip, the formation by intersecting planes with a hollow tip, was used by Metz, *supra,* and shown by Alsaker, *supra.* Appellant complains that these inventions are different, since each

design embodied more than two intersecting planes. However, a mere difference in the number of planes and corresponding apexes, if inventive, suggests severable patentability rather than combination; **and, in any case, appellant was anticipated by Alsaker's statement that 'while I have shown four such cutting edges, obviously a less or greater number might be employed without departing from the invention.'** This statement is of particular significance because the Alsaker patent was not considered by the patent office." (Pet. 23-24) (Emphasis added)[6]

There is no conflict between the decision below and the decision of this Court in *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364 (1942). (Pet. 12-14) The Court below clearly recognized that "It is only the improved punching tip which is claimed and not the remaining elements of the T-fitting in which the punching tip is used." (Pet. 14)

It found that "the improved punch tip, *per se*" (Pet. 14) was old and properly invalidated the patent.

## CONCLUSION

For the foregoing reasons Respondent respectfully submits that the Petition for Writ of Certiorari should be denied.

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6. The second quotation at Pet. 12 is of a *partial* sentence. It significantly omits the portion of the opinion reproduced in bold face above which demonstrates the inaccuracies in Petitioner's argument.